In the Drawings

There are no amendments to the drawings.

Remarks

Applicant has amended Claims 6, 8-11, 14, 18 and 26-27, cancelled Claims 1, 17, 19-25 and 30-34. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. (*See*, pp. 15-16, originally filed Claims 27, 30 & 31). Entry of the amendment and favorable consideration thereof is earnestly requested.

As amended, Claim 27 requires "a configurable hardware device . . . including a non-overwritable portion that requests said software program" and the "non-overwritable portion loads said program on said processor." Applicant respectfully submits that the prior art fails to disclose or teach these limitations.

For example, U.S. Patent No. 5,627,583 ("Nakamura et al.") fails to teach that that the LCA comprises a "non-overwritable portion" as required by Claim 27. (See, Col. 4, lines 23-32). Rather, Nakamura et al. teaches that the LCA only comprises a "matrix of logic blocks . . . and a plurality of I/O blocks" and that a "logic circuit is formed by a configuration program based on the circuit data mentioned above." (Col. 4, lines 24-31). Therefore, not only does Nakamura et al. fail to teach a non-overwritable portion, Nakamura et al. teaches away from this limitation as all of the blocks are configurable. (*See*, Col. 4, lines 32-42).

Applicant further submits that Nakamura et al. fails to teach that the LCA "requests said software program" or that the "non-overwritable portion loads said program on said processor" as required by Claim 27. (See, Col. 4, lines 23-32). For example, Nakamura et al. teaches that the CPU identifies the connected endoscope, and loads the circuit data onto the LCA. (*See*, Col. 5, lines 29-30 & 58-61; Col. 8, lines 2-4 & 53-59; Col. 10, lines 42-45; Col. 11, lines 30-32 & 55-57). Nowhere however, does Nakamura et al. teach, disclose or suggest that the "configuration program" is requested or loaded by a "non-overwritable portion" of the LCA. (Col. 4, lines 30-31).

It is well settled that the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. *See, e.g.,* MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). In the present case, Applicant respectfully submits that there is no motivation to modify Nakamura et al. according to the presently pending claims to include a non-overwritable portion to request and load the program in lieu of the CPU as taught in Nakamura et al. Rather, the only motivation for discarding this integral teaching of Nakamura et al. is the presently pending claims, which is inappropriate. *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992) ("There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the

combination. That knowledge can not come from the applicant's invention itself."); *See also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's disclosure).

The Examiner has submitted that, the cited art fails to disclose a "non-overwritable portion", but that "Official Notice is taken that it is well known in the computing art to provide non-overwritable portions containing a function of writing a program on reconfigurable devices to ensure that the device can function properly even in the event that a new program is improperly written to the array" and that therefore "it would have been obvious . . . to include a non-overwritable portion to ensure that recovery is possible even when a program is improperly written." (Official Action, pp. 14-15). Alternatively, Applicant respectfully submits the specification teaches that the CCU must be individually configured for each connected endoscope, so the non-overwritable portion could not be used "to ensure that the device can function properly" as suggested. (*See*, pp. 3-4). Rather, the "non-overwritable portion" is used to request the program for configuring or programming a configurable or programmable portion. (*See*, pp. 11 & 16).

Applicant further respectfully submits that neither U.S. Patent No. 6,295,082 ("Dowdy et al.") nor U.S. Patent No. 6,638,212 ("Oshima") teach, disclose or suggest a "non-overwritable portion" or that the non-overwritable portion "requests said software program."

Accordingly, because none of the cited art teaches, discloses or suggests "a configurable hardware device . . . including a non-overwritable portion that requests said software program" and the "non-overwritable portion loads said program on said processor" as required by Claim 27, none of the cited art alone or in any combination can render Claim 27 obvious.

It is respectfully submitted that Claims 6, 8-16, 18 and 26-29 are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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